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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,379	12/18/2000	Janine L. Helms	10004480-1	8819

7590 10/19/2005

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EXAMINER

LAZARO, DAVID R

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/745,379	HELMS, JANINE L.
	Examiner David Lazaro	Art Unit 2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 September 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 09/22/05.
2. Claims 1-20 are pending in this office action.

Response to Amendment/Arguments

3. Applicant's arguments, see page 7 of the remarks, filed 09/22/05, with respect to the rejection(s) of claim(s) 11-26 under 35 U.S.C. §103 as being obvious over Leong (U.S. Patent 5,996,010) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. As such, the finality of the previous office action is also withdrawn. Upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent 6,618,162 by Wiklof et al. Furthermore, in considering the new grounds of rejection, the examiner is obligated to also present a rejection of Claims 1-4 and 6-10, which were previously allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 10-12, 15, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,618,162 by Wiklof et al. (Wiklof).
6. With respect to Claim 1 and 10, Wiklof teaches a method providing peripheral device management through a firewall, the firewall blocking unauthorized access to a plurality of peripheral devices in an intranet, the method comprising:
 - pre-configuring a peripheral device (Col. 3 lines 16-20 - printer 16 or 18) to communicate a request to a predetermined web site web site upon booting up in the intranet (Col. 4 line 63 - Col. 5 line 6), the web site being hosted by a server that does not have direct intranet access (Col. 3 lines 16-36 and Col. 4 lines 47-53 - printers are on a first LAN, web site server is on a second LAN that is distinct from the first LAN, the LANs are coupled through the Internet);
 - receiving the request at the predetermined web site from the preconfigured peripheral device (Col. 4 line 63 - Col. 5 line 6);
 - In response to receiving the request:
 - generating a response based on the request, the response comprising one or more control commands used by the preconfigured peripheral device to perform one or more functions (Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33);
 - and
 - communicating the response to the preconfigured peripheral device (Col. 4 line 63 - Col. 5 line 6).
7. With respect to Claim 2, Wiklof teaches all the limitations of Claim 1, wherein the predetermined web sit is a printer management service (Col. 3 lines 16-36 and Col. 4

lines 47-53), the response is a printer configuration (Col. 5 lines 18-25 and Col. 6 lines 8-33), and the peripheral device is a printer (Col. 3 lines 16-20 - printer 16 or 18).

8. With respect to Claim 3, Wiklof teaches all the limitations of Claim 1, wherein the request is a configuration request (Col. 4 line 63 - Col. 5 line 6), the method further comprising:

determining a default device configuration corresponding to the peripheral device (Col. 5 line 51 - Col. 6 line 34); and

wherein the response further comprises the default device configuration (Col. 5 line 51 - Col. 6 line 34).

9. With respect to Claim 4, Wiklof teaches all the limitations of Claim 3, wherein the determining further comprises presenting a user interface to a customer for the customer to select one or more configuration settings corresponding to the peripheral device (Col. 4 lines 35-53).

10. With respect to Claims 11 and 16, Wiklof teaches a method comprising:
communicating, by a peripheral device in a corporate intranet (Col. 3 lines 16-20 - printer 16 or 18 in a first LAN), a configuration request to a predetermined web site (Col. 4 line 63 - Col. 5 line 6) hosted by a server that is not in the corporate intranet (Col. 3 lines 16-36 and Col. 4 lines 47-53 - printers are on a first LAN, web site server is on a second LAN that is distinct from the first LAN, the LANs are coupled through the Internet);

in response to the communicating, receiving a predetermined device configuration from the predetermined web site (Col. 4 line 63 - Col. 5 line 6); and in

response to the receiving, configuring the peripheral device based on the predetermined device configuration (Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33).

11. With respect to Claim 12, Wiklof teaches all the limitations of Claim 11, wherein the predetermined web sit is a printer management service (Col. 3 lines 16-36 and Col. 4 lines 47-53), the response is a printer configuration (Col. 5 lines 18-25 and Col. 6 lines 8-33), and the peripheral device is a printer (Col. 3 lines 16-20 - printer 16 or 18).

12. With respect to Claim 15, Wiklof teaches all the limitations of Claim 11, further comprising: in response to a condition, forwarding, a notification message to the predetermined web site (Col. 4 line 63 - Col. 5 line 6);

receiving a notification response based on the notification message from the predetermined web site, the response comprising a set of control functions (Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33);

in response to receiving the notification response, implementing one or more of the set of control functions (Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of U.S. Patent 6,938,079 by Anderson et al. (Anderson).

15. With respect to Claim 6, Wiklof teaches all the limitations of Claim 3, but does not explicitly disclose encoding the device configuration as a web page comprising XML; and wrapping the encoded device configuration in HTTP such that a peripheral device that includes an embedded web server can parse and execute the encoded device configuration to configure one or more settings or resources that correspond to the peripheral device. Anderson teaches configuration information can be encoded into XML and wrapped in HTTP in order to configured the corresponding device (Col. 8 lines 1-16, Col. 26 lines 44-60, Col. 45 lines 24-34, Col. 46 lines 15-26). XML is known for its platform independence and can therefore provide for universal acceptance (Col. 15 lines 28-67 and Col. 8 lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Anderson such that the method further comprises wherein the forwarding further comprises: encoding the device configuration as a web page comprising XML; and wrapping the encoded device configuration in HTTP such that a peripheral device that includes an embedded web server can parse and execute the encoded device configuration to configure one or more settings or resources that correspond to the peripheral device. One would be motivated to have this, as it is desirable for configuration information to be universally implemented (In Anderson: Col. 7 lines 28-50).

16. With respect to Claim 14, Wiklof teaches all the limitations of Claim 11, and further teaches determination of one or more device settings or resources specified by the predetermined device configuration.

Wiklof does not explicitly disclose the peripheral device comprises an embedded web server for parsing web pages, the received predetermined device configuration is a web page comprising encoded XML wrapped in HTTP, the configuring further comprising: parsing the XML and HTTP to determine one or more device settings or resources specified by the predetermined device configuration. Anderson teaches the use of a embedded web server for parsing web pages such as those defined by XML (Col. 15 lines 42-54). Anderson teaches configuration information can be encoded into XML and wrapped in HTTP in order to configured the corresponding device (Col. 8 lines 1-16, Col. 26 lines 44-60, Col. 45 lines 24-34, Col. 46 lines 15-26). XML is known for its platform independence and can therefore provide for universal acceptance (Col. 15 lines 28-67 and Col. 8 lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Anderson such that the method further comprises the peripheral device comprises an embedded web server for parsing web pages, the received predetermined device configuration is a web page comprising encoded XML wrapped in HTTP, the configuring further comprising: parsing the XML and HTTP to determine one or more device settings or resources specified by the predetermined device configuration. One would

be motivated to have this, as it is desirable for configuration information to be universally implemented (In Anderson: Col. 7 lines 28-50).

17. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of U.S. Patent 6,317,848 by Sorens et al. (Sorens).

18. With respect to Claim 7, Wiklof teaches all the limitations of Claim 1 but does not explicitly disclose providing an e-mail address, the request being a notification message that is communicated to the e-mail address. Sorens teaches providing an e-mail message in which a notification message is communicated to the e-mail address (Col. 1 lines 49-58 and Col. 2 line 52 - Col. 3 line 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Sorens such that the method further comprises providing an e-mail address, the request being a notification message that is communicated to the e-mail address. One would be motivated to have this, as it provides an inexpensive way for communicating notifications to those responsible in part for the management of the device (In Sorens: Col. 1 lines 34-41).

19. With respect to Claim 9, Wiklof teaches all the limitations of Claim 1, and further teaches the managing further comprising: determining a response based on the request, the response specifying a set of control functions that address the request; and forwarding the response to the peripheral device such that the peripheral device can

implement the set of control functions (Col. 4 line 63 - Col. 5 line 6, and Col. 5 lines 18-25 and Col. 6 lines 8-33).

Wiklof does not explicitly disclose providing an e-mail address, the request being a notification message being sent in response to the occurrence of a condition on the peripheral device. Sorens teaches providing an e-mail message in which a notification message is communicated to the e-mail address in response to the occurrence of a condition on the device (Col. 1 lines 49-58 and Col. 2 line 52 - Col. 3 line 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Sorens such that the method further comprises providing an e-mail address, the request being a notification message being sent in response to the occurrence of a condition on the peripheral device; the managing further comprising determining a response based on the notification message, the response specifying a set of control functions that address the notification message; and forwarding the response to the peripheral device such that the peripheral device can implement the set of control functions. One would be motivated to have this, as it provides an inexpensive way for communicating notifications to those responsible in part for the management of the device (In Sorens: Col. 1 lines 34-41).

20. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of Sorens and U.S. Patent 6,003,078 by Kodimer et al. (Kodimer).

21. With respect to Claim 8, Wiklof in view of Sorens teaches all the limitations of Claim 7, and further teaches the peripheral devices is a printer (In Wiklof: Col. 3 lines 16-20), but does not explicitly disclose the response is selected from a group of responses comprised of ordering a toner cartridge for the printer or dispatching a service representative to service the printer on-site.

Kodimer teaches a response can include a selection from a group of responses comprised of ordering parts for a printer or dispatching a service representative to service the printer on-site (Col. 1 lines 41-53 and Col. 12 lines 52-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof in view of Sorens and modify it as indicated by Kodimer such that the method further comprises wherein the peripheral devices is a printer and the response is selected from a group of responses comprised of ordering a toner cartridge for the printer or dispatching a service representative to service the printer on-site. One would be motivated to have this, as it is desirable to reduce the difficulties of maintaining network peripherals (In Kodimer: Col. 1 lines 12-53).

22. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of Kodimer.

23. With respect to Claim 13, Wiklof teaches all the limitations of Claim 11, but does not explicitly disclose the peripheral device comprises an embedded web server for generating web pages, the communicating further comprising encoding the

configuration request as a web page. Kodimer teaches a peripheral device can include an embedded web server for generating web pages (Col. 5 lines 12-21). The embedded web server allows for communication of configuration information in the form of web pages (Col. 5 lines 12-21 and Col. 10 lines 57-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Kodimer such that the method further comprises the peripheral device comprises an embedded web server for generating web pages, the communicating further comprising encoding the configuration request as a web page. One would be motivated to have this, as it is desirable to reduce the difficulties of maintaining network peripherals (In Kodimer: Col. 1 lines 12-53).

24. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of U.S. Patent 6,345,294 by O'Toole et al. (Toole).

25. With respect to Claim 17, Wiklof teaches a system comprising: a web site being configured to determine a default device configuration corresponding to a peripheral device (Col. 5 line 51 - Col. 6 line 34), the peripheral device (Col. 3 lines 16-20 - printer 16 or 18) being pre-configured to communicate a request to the web site upon being booted up in an intranet (Col. 4 line 63 - Col. 5 line 6), the web site not being hosted by a server that is part of the intranet (Col. 3 lines 16-36 and Col. 4 lines 47-53 - printers are on a first LAN, web site server is on a second LAN that is distinct from the first LAN, the LANs are coupled through the Internet), in response to receiving the request, the

web site is configured to communicate the default device configuration to the peripheral device (Col. 4 line 63 - Col. 5 line 6), the default device configuration being used by the peripheral device to configure itself (Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33).

Wiklof does not explicitly disclose the intranet is protected by a firewall and the configuration being communicated through the firewall. Toole teaches a intranet may include a firewall and that a peripheral device to be configured (see abstract) may be behind that firewall (Col. 6 lines 39-53). In one embodiment, Toole teaches communications through firewalls to a peripheral device can be implemented by using HTTP (Col. 25 lines 5-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Wiklof and modify it as indicated by Toole such that the intranet is protected by a firewall and the default device configuration is communicated through the firewall. One would be motivated to have this, as firewalls are commonplace in LANs and there is need to be able to communicate configuration information to devices behind firewalls (In Toole: Col. 6 lines 39-53 and Col. 25 lines 5-17).

26. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of Toole and Anderson.

27. With respect to Claim 18, Wiklof in view of Toole teaches all the limitations of Claim 17, but does not explicitly disclose wherein the peripheral device comprises an

embedded web server to communicate the request as a web page and to parse the communicated default device configuration, the communicated default device configuration being communicated as a web page.

Anderson teaches the use of an embedded web server to communicate the request as a web page and to parse the communicated default device configuration (Col. 15 lines 42-54), the communicated default device configuration being communicated as a web page in XML format (Col. 8 lines 1-16, Col. 26 lines 44-60, Col. 45 lines 24-34, Col. 46 lines 15-26). XML is known for its platform independence and can therefore provide for universal acceptance (Col. 15 lines 28-67 and Col. 8 lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Wiklof and modify it as indicated by Anderson such that the system further comprises wherein the peripheral device comprises an embedded web server to communicate the request as a web page and to parse the communicated default device configuration, the communicated default device configuration being communicated as a web page. One would be motivated to have this, as it is desirable for configuration information to be universally implemented (In Anderson: Col. 7 lines 28-50).

28. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiklof in view of Toole and Anderson and in further view of Sorens.

29. With respect to Claim 19, Wiklof in view of Toole and Anderson teaches all the limitations of Claim 18 and further teaches the request comprising a notification message that was generated by the peripheral device in response to a predetermined condition, the response being based on the received request (In Wiklof: Col. 4 line 63 - Col. 5 line 6).

Wiklof in view of Toole and Anderson does not explicitly disclose the server that hosts the web site comprises an e-mail address, the request being communicated to the e-mail address. Sorens teaches providing an e-mail message in which a notification message is communicated to the e-mail address (Col. 1 lines 49-58 and Col. 2 line 52 - Col. 3 line 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Wiklof in view of Toole and Anderson and modify it as indicated by Sorens, such that the system further comprises disclose the server that hosts the web site comprises an e-mail address, the request being communicated to the e-mail address. One would be motivated to have this, as it provides an inexpensive way for communicating notifications to those responsible in part for the management of the device (In Sorens: Col. 1 lines 34-41).

30. With respect to Claim 20, Wiklof in view of Toole, Anderson and Sorens teaches all the limitations of Claim 19, and further teaches wherein the response comprises one or more control codes corresponding to functions to be performed by the peripheral device upon receipt of the response (In Wiklof: Col. 4 line 63 - Col. 5 line 6, Col. 5 lines 18-25 and Col. 6 lines 8-33).

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
32. U.S. Patent 5,905,906 by Goffinet et al. "Method and apparatus for configuring multiple printers on a network" May 18, 1999.
33. U.S. Patent 5,960,167 by Roberts et al. "Printer configuration system" September 28, 1999.
34. U.S. Patent 6,308,205 by Carcerano et al. "Browser based network management allowing administrators to use web browser on user's workstation to view and update configuration of network devices" October 23, 2001.
35. U.S. Patent 6,915,337 by Motoyama et al. "Method and system for updating the device driver of a business office appliance" July 5, 2005.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Lazaro
October 12, 2005


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER